

## **REMARKS**

At the outset, Applicant wishes to thank Examiner Suhol for taking the time on November 5, 2004, to meet with the inventor Dr. Helen McIntosh and Carol Sutton Lumpkin, President of The Peace Rug, Inc., the company that markets the invention, and their attorney Edward J. Kondracki and affording an opportunity to describe the merits of the invention to him and the deficiencies of the references relied on. As agreed, at the interview, Applicants are submitting a new set of claims and arguments, along with an affidavit/declaration of the inventor Dr. Helen McIntosh to further describe the invention and how it overcomes the prior art. No new matter has been added, and the physical attributes of "The Peace Rug" can be found at page 6, lines 9-32.

The Office Action dated June 30, 2004, and cited references have been carefully reviewed and the application has been amended by canceling Claims 1-27 and 32-37, and replacing these claims with new claims 38-43 directed specifically to the article of manufacture and teaching tool used for cognitive resolution of conflicts and interpersonal issues. As noted at the interview with Examiner Suhol, there are multiple facets to the invention. First there is the inventive process which will be made the subject of a divisional application. Second, there is the article of manufacture used to resolve conflicts and interpersonal issues and the specific teaching tool. Claims 38-41 are directed to the article of manufacture and are intended to protect against unauthorized manufacture. Claims 44-46 are directed to the specific teaching tool and are intended to protect against unauthorized use.

### **Summary of the Office Action**

Original Claims 24, 26-27, 32, and 36 stand rejected under 35 U.S.C. §102 over Sherin '106. Original Claims 25, 33, 35 and 37 stand rejected under 35 USC

§103(a) over Sherin '106 and original Claim 32 stands rejected under 35 USC §103(a) in view of Laz, "The Six Levels of a Happy Marriage". Original Claim 33 stands rejected under 35 USC 103(a) over Laz and Sherin '106 and further in view of Lui et al '696.

### **The Claims**

The original Claims 1-27 and 32-37 have been canceled and the application has been limited to new Claims 38 and 43. Process Claims 28-31 have been withdrawn from prosecution and are being made the subject of a separate divisional application.

It is respectfully submitted that each of Claims 38-43 clearly and patentably distinguish the references and places the application in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

### **The Sherin Reference**

Sherin discloses a kit to evaluate the cooperative skills of individuals in a group environment. An evaluator, observer or facilitator is required to evaluate the skills of individuals using the kit. The kit contains containers or boxes which in turn contain geometric puzzle pieces for each group of five participants. The kit also contains instructions for the participants, observer and evaluator. The task of each individual is to properly assemble the puzzle pieces for a predetermined pattern, e.g., a square as stated at col. 3, line 19. A critical requirement is five participants. There is also an observer who observes results and reports. As pointed out to Examiner Suhol, it should be noted that the "Rules" prohibit both verbal and non-verbal communications, col. 4, lines 33-36. This is contrary to the teachings of the present invention.

Sherin is not a system for cognitive resolution of conflicts. It does not relate to children having interpersonal conflicts and solving their own conflicts. It does not utilize a rug for establishing a conflict resolution area. It does not provide a script to encourage resolution of conflicts. The participant's instructions of Sherin relate to "Task" – assemble one complete square; "Rules" which prohibit verbal and non-verbal communications (emphasis added); and "Mission" – Every person to assemble one complete square of equivalent size (col. 4, line 7-17).

### **The Laz Reference**

Laz is a book using insights from "Marriage Encounter" sequences to provide a guide for couples wishing to assess their relationship and improve their marriage and suggest that spouses sit down and share their feelings. It is not directed to children. It is not classroom oriented. It does not utilize a rug for establishing a specific conflict resolution area.

### **The Combinations of Sherin and Laz**

There is nothing in Sherin that suggests or motivates one to apply the general concepts of Laz to Sherin. Indeed, the prohibition against verbal and non-verbal communications in Sherin is directly contrary to the teachings of Laz, as well as the present invention.

### **The Lui et al. reference**

Lui et al. is directed to improving an individual's ability to identify and express emotions by an educational device relying on the classification and placement of "emotion" blocks on a surface with the emotion side up. Lui et al. was cited for the statement in par. 39, "The facilitator may assist the user in performing the invention by engaging the user in conversation designed to assist the user in forming and communicating the association between the identified emotions and needs".

The Examiner's comment no doubt stems from the decision of the Federal Circuit in In re Gulack 217 USPQ 401 (CAFC 1983) wherein the court would not give patentable weight to printed matter absent a new and unobvious relationship between the printed matter and the substrate. However, in the more recent case of In re Lowry, 12 USPQ2d, (CAFC 1994), the Federal Circuit noted that in Gulack it cautioned against a liberal use of "printed matter" rejections. The Court stated:

A "printed matter" rejection under §103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art ...[The Court of Customs and Patent Appeals]. Notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated. Gulack, supra, n.8.

The printed matter cases have no factual relevance where the printed matter does not form an element of the claims. In the subject application, there are two essential elements, a rug and a script having a certain functional interrelationship not heretofore known in the prior art. The script need not be written. It is this combination that needs to be addressed.

The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. The PTO may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384; see also Diamond v. Diehr, 450 U.S. 175, 191 [209 uspq1] (1981).

Accordingly, even assuming, arguendo, that the printed matter is deemed an essential element of the combination, it must be remembered that as part of its burden to establish a *prima facie* case of obviousness, see In re Oetiker 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is

There is nothing in this paragraph that suggests incorporation of a statement in the script describing a request on the part of a speaker engaged in this conflict resolution process. In Applicant's invention, as claimed, there is no facilitator or observer, just two participants, most likely children, in face to face contact trying to solve a mutual, interpersonal conflict through use of a symbolic rug deemed "The Peace Rug" and an associated script means.

### **The Use of Script**

The Examiner has indicated that the script or other associated indicia needs to be functionally related to the substrate that carries it in order to have patentability. It should be noted at the outset that there is no requirement that the script be written. Further, as in Sherin '106, the script means of the invention is a separate element in and of itself and is associated with the rug to form a teaching tool. It may be in various forms such as tape, diskette or written. In theater parlance, as in here where parties are speaking script is thought of as the lines to be spoken by a given actor. See Webster's New 20<sup>th</sup> Century Dictionary of the English language, Unabridged pg. 1530, 1531.

The Examiner has assumed the instructions to be written and asserts that this element (instructions) as claimed must be considered separate and apart from any specific indicia that may be contained thereon so long as no indicia are claimed. Claims 38 and 42 do not depend on any particular indicia or any written instruction and define the function of the script in means plus function format. (35 USC 112) In the commercial embodiment of "The Peace Rug" the instructions are presented on tape as well as in text format. The specification does not limit the instructions to any particular form and is intended to include all forms by which lines to be spoken may be presented to the persons involved in the conflict resolution process.

entitled to grant of the patent.” Id. The Examiner has not established that use of a rug and script within the context of the specification and claims, lacks a new and nonobvious functional relationship particular either as an article of manufacture or as a teaching tool.

### **Obviousness and Secondary Consideration**

As discussed at the interview with the Examiner, the subject invention has achieved immediate acceptance with those concerned with conflict resolution in classrooms. The Declaration of Dr. Helen McIntosh is submitted herewith and incorporated by reference in its entirety as part of this response. Several testimonials of professionals are included. The invention has been recognized by the inventor’s peers and has received the School Bell Award by the Georgia Association of Elementary School Principals. It is licensed for manufacture by a major rug company, Shaw Rugs. The invention has satisfied a long felt need. These attributes are recognized by the Supreme Court in Graham et al. v. John Deere Company 148 USPQ 459 (SC 1966) as indicative of patentability. Under 35 USC 103, the scope and content of the prior art are to be determined, the differences between the prior art and the claims at issue are to be ascertained and the level of ordinary skill in the pertinent art resolved. Against this background, secondary considerations such as commercial success, long felt, but unsolved needs, and failure of others to come forth with practical solutions to solve the problem have relevancy and can shed light on the question of patentability. Applicant has set forth the differences and deficiencies of the prior art of record and the affidavit of Dr. Helen McIntosh and her doctoral dissertation mandate a ruling in favor of patentability.

## Summary

The invention, termed “The Peace Rug”, is an extremely simple method, process or system where children can go to a specially designed place defined by a small rug that is movable, transferable and portable. It is not a fixed location, but rather the place defined by placement of a rug which is the child’s choice. After being taught very simple instructions, children are allowed, using a set of lines to be spoken or prepared script, to work out between or among themselves whatever problem, referred to as “conflict” has occurred. The place where the rug rests establishes a conflict resolution area defined by area of the rug. The script or lines to be spoken take from whatever media is most conveniently available, forms the basis for resolution of the conflict when acted out.

Classroom conflicts result when one child disrespects, hurts, taunts, gossips about, takes someone’s pencil or someone’s bookbag, kicks, bites, scratches, teases, bullies or displays any other negative behavior towards another child and/or children. Any child’s hurtful behaviors towards another child that have to do with another’s body, feelings, or property can be dealt with on The Peace Rug.

The children use this cognitive resolution process by themselves. There is no observer or facilitator. Its simplicity makes it most effective and is embraced by children who are now empowered to solve their own problems. The purpose is to help children resolve negative feelings before they build to out of control anger and/or violence. Conflicts can be “nipped in the bud”.

In the simplest of terms, a special place is determined by placement of a rug called The Peace Rug where you can take someone who hurts your feelings, your body or your property and you talk to them about it face to face to try to resolve the problem. The Peace Rug and script form a two-part teaching tool. The rug can be left

out in the classroom or rolled into a roll and stored elsewhere. It is small enough to be carried by a child to any location in the classroom or to the area designated by the teacher or other adult or location in the home. When the rug is placed on the floor, it defines the conflict resolution area.

The invention is claimed as an educational tool and as an article of manufacture. It is a qualified counseling curriculum for schools as well as a product manufactured and shipped by a carpet manufacturer.

It is unlike Sherin; because there are no observers for The Peace Rug and there are no geometric pieces to assemble, and contrary to Sherin does not demand silence of the participants, rather it encourages mutual statements and eventual agreements.

There are no pieces or documents or blocks (Unlike Lui) or instruments or writing tools or cells to decide (unlike Mackay) or baskets (unlike Gaither) or intimacy (Unlike Laz) or assessments (unlike Weeks).

The invention does not try to identify personality characteristics (unlike Weeks); or evaluate the cooperative skills of individuals in a group environment (unlike Sherin); the invention does not have people create messages for each other in a predetermined located container at a predetermined time (unlike Desplace); does not use extraneous sources to try to get children to identify how they are feeling (unlike Lui); does not assist in intimate relationships (unlike Laz).

No facilitator is required. There are no observers. No intimacy is involved. The children themselves resolve whatever problem has arisen when it happens so that they can quickly resume their educational instruction in their classroom or resume activities in the home.

**None of the cited patents has anything to do with teaching children a simple and easy way to resolve conflicts or to just simply get along with each**

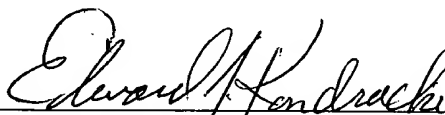


**other, using the claimed invention. None disclose nor suggest the claimed invention. Simplicity is not a bar to patentability and a rejection based on simplicity has no statutory basis.**

Should the Examiner believe that further amendments are necessary to place the application in condition for allowance, or to more expeditiously resolve any remaining issues, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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